



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,634	09/13/2000	Shirwan Alpasha Al Bahdani		5682

23517 7590 10/14/2004

SWIDLER BERLIN SHEREFF FRIEDMAN, LLP
3000 K STREET, NW
BOX IP
WASHINGTON, DC 20007

EXAMINER

TRIEU, THAI BA

ART UNIT	PAPER NUMBER
----------	--------------

3748

DATE MAILED: 10/14/2004

45

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,634

Applicant(s)

AL BAHDAINI, SHIRWAN
ALPASHA

Examiner

Thai-Ba Trieu

Art Unit

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 33-54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

This Office Action is in response to the Request for Continued Examination filed on July 09, 2004. Applicant's cooperation in correcting the informalities in the Abstract is appreciated. Claims 1-32 were cancelled, and claims 33-54 were added.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ***"feeding accessories"*** and ***"automatic management"*** (See Claim 33); ***"a compound unit"*** (See Claim 34); ***"a typical bridge to cover that wide gap between pistons system and the turbine system"*** (See Claim 37); ***"the same spraying device"*** (See Claim 38) and etc... must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

1. The amendment filed on April 12, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material in the Amendment, which is not supported by the original disclosure is as follows: ***Page 7, lines 23-24, Page 20, line 14-32, Pages 21-24, lines 1-33, and Page 25, lines 1-2.***

2. The amendment filed on July 21 and August 05, 2003 are objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material in the Amendment, which is not supported by the original disclosure is as follows: ***Page 24, lines 14-20, Page 28, lines 5-9, Page 31, lines 19-32, Pages 32-33, line 1-34*** (See Clean Version of the Amendment filed on July 21, 2003); ***Page 31, lines 28-32, Page 35, lines 5-10, Page 37, lines 24-30.*** Additionally, they contains new matters such as the relation of using of the physical principle of

Art Unit: 3748

escaping a space-ship from the earth gravity and the piston working in the closed pocket engine by employing the centrifugal concept.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Specifically, in claim 33, line 11, ***“means to form”*** is required to be incorporated with the specification.

Claim Objections

Claims 33, 38, and 42 are objected to because of the following informalities:

- Applicant is required to correct some grammatical errors such as:

1. In claim 33, lines 2-3: ***“this engine comprising a case 2 has a cylindrical cavity...”*** should be replaced by -- ***this engine comprising a case 2 having a cylindrical cavity....*** .

2. In claim 33, line 12, ***“three group or more of ...”*** should be replaced by – ***three or more groups of ...***.

3. In claim 33, line 13, ***“a radial locations ...”*** should be replaced by – ***a radial location ...***.

4. In claim 33, lines 46-47, -- a -- should be inserted before ***“central oil canal 24”***.

5. In claim 33, lines 49-50, -- **the** -- should be inserted before “**central oil canal 24**” (for avoiding double recitation).

6. In claim 38, lines 22-23, “**characteristic**” and “**to establishing**” should be replaced by -- **characteristics** -- and -- **to establish** --; and “**The Automatic... Engine**” should be replaced by -- **An Automatic ... Engine** -- or -- **Automatic ... Engines** --.

7. In claim 42, the recitation of “**the indicator diagram for both claims 9 and 10**” should be revised, since claims 9 and 10 were cancelled; and “**the indicator**” should be replaced by -- **an indicator** -- (for correcting the non antecedent basis in claims).

Appropriate correction is required.

Overall, Applicant should rewrite all claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

Art Unit: 3748

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because of failing to provide an adequate written description of the invention.

Claims 33-54 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically,

- In claim 33, line 9, the recitation of **“cylinder bas”** lacks a proper explanation thereof in the specification. What does the cylinder bas mean?

- In claim 33, lines 10-11, the recitation of **“consisting a means to form hydraulic sliding rod pump”** lacks a proper explanation thereof in the specification.

- In claim 33, line 54, the recitation of **“relevant data”** lacks a proper explanation thereof in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claims 33-54 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Applicant should review all of claims in record and make correction in compliance with 35 U.S.C. 112, second paragraph 2.

Claims 33-54 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example

1. Regarding claim 33:

a. The phrase **"looks like"** (See line 2); **"or alike"** (See lines 9, 39, 41-42), **"or a place alike nearby"** (See line 47) render the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

b. The phrase **"i.e. cylinder bas"** (See line 9), and **"i.e. increase its flywheel rotation"** (See lines 29-30) render the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

c. Lines 25-26, the recitation of “ ***in specific design***” renders the claim indefinite, since it is not clear that how specific design to be used to expel the resulting exhaust gases while creating beneficial aerodynamic effects?

d. Line 30, the recitation of “ ***an action similar to a turbine effect***” renders the claim indefinite, since it is not clear that how similar is an action to be compared with a turbine effect?

e. Lines 47-48, the recitation of “ ***specially***” renders the claim indefinite, since it is not clear that how special is the piston(s) to be used as engine parts?

f. Line 41, the recitation of “ ***all***” renders the claim indefinite, since it is not clear that “***all***” is used to reference to which theses element(s), limitation(s), or process(es). Applicant is required to identify element(s), limitation(s), or process(es).

g. Line 54, the recitations of “***like starting motor***” and “***(etc.)***” render the claim indefinite, since it not clear that how many additional devices applicant wants to reference to.

h. Lines 54-55, the recitation of “ ***the relevant data will govern the whole dimensions***” renders the claim indefinite, since it is not clear that which relevant data and are to be referenced to, and which dimension is to be defined? Applicant is required to identify the data and define the dimensions.

i. Lines 57-58, the recitation of “ ***all could be controlled in the engine by an automatic management***” renders the claim indefinite, since it is not clear that “all” is used to reference to which element(s), limitation (s), or process (es). Applicant is required to identify the element(s), limitation(s), or process(es). Then, under which condition the element(s), limitation(s), or process(es) could be controlled, and under which condition they could not be controlled. Applicant is required to define these conditions. Additionally, the recitation of “***automatic management***” is used to reference to which element in the system, and this recitation is required to incorporate with the specification.

2. Regarding claim 34, “*the feature of Piston, Rotary and Turbine principles, to **perform all together** in a compound unit designed in smooth simple mechanism system to provide **best utility** for potential fuel combustion power with new technique of concentrating the reactions of physical kinetic power occurred **by elements** inside the engine, to have almost of them beneficially applied on engine automotive output*” renders the claim indefinite, since it is not clear that how the principles of the piston, rotary, and turbine can perform all together in a compound? The principles of Piston, the principles of rotary, and the principles of turbine are related and work together in a compound unit? Which systems are used to be compared to the simple mechanism system of the instant invention in order that the instant application system has the best

Art Unit: 3748

utility for potential fuel combustion power? Which elements are used to reference to, applicant is required to identify these elements.

3. In claim 36, ***“physical reaction that would be inverted to create influence increasing the rotation speed of the flywheel(s) therewith in the engine”*** renders the claim indefinite, since it is not clear that when the physical reaction is inverted to create influence, and when the physical reaction is not inverted to create influence. These conditions are required to be defined.

4. In Claim 37, the recitations of ***“ relevant flywheel(s)”***, ***“in which in this design”***, ***“minimum energy lost as all associated”***, and ***“this could establish a typical bridge.... Piston system and turbine system ...”*** render the claim indefinite since it is not clear that how relevant the flywheel(s) is/are; in which situation/condition/feature/ machine/device/element appear(s) to be in this design; to which “all” is used to reference to; which element “this” is used to be reference to, under which condition this could or could not establish a bridge to cover that wide gap..., and how typical the bridge is. These conditions are required to be clarified.

5. In Claim 38, the recitation of ***“the principle of this discipline”*** renders the claim indefinite, since it is not clear that which principle of which discipline is to be claimed. The recitation of ***“the flexibility in this system”*** renders the claim indefinite, since it is not clear that applicant wants to reference to which system. The recitations of

“keeping the best firing stroke”, “any fuel mixture efficiency even with the same spraying device, also Gas fuel could be used for each group”, “the automatic control could be significantly used for each group”, “all conditions”, “any piston could work”, and “the other parts of engine” render the claim indefinite, since it is nor clear that how best the firing stroke is to be kept; how the same the spraying device is; how significantly the automatic feeding control could be used for each group; under which condition the automatic feeding control could be significantly used, and could not be significantly used for each group; which group applicant wants to reference to; which conditions are considered as “all conditions”, and which parts of engine are considered as other parts of engine to be badly influenced.

6. In Claim 39, the phrase ***“i.e. on piston cup directly”*** (See line 2), and ***“i.e. those unstable gases like”*** (See line 12) render the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Additionally, the recitations of ***“the scavenging of pure air.....would provide perfect”, “air pressure and temperature could be controlled”, “the puffing mission could be done”, “this built-in technique”, and “specific anti-pollution treating materials”*** render the claim indefinite, since it is nor clear that how perfect the scavenging of pure air; under which condition the air pressure and temperature could be or could not be controlled; which is the built-in technique, and how specific the anti-pollution treating materials. Those limitations are required to be clarified.

7. In claim 40, the recitations of ***“specific suggested devices”***, and ***“the engine oil sump located far from chambers”*** render the claim indefinite, since it is not clear that how specific the devices are to be suggested, and how far from the chambers the engine oil sump is to be positioned. Those limitations are required to be clarified.

8. In claim 41, the phrase ***“i.e. reductions of chamber(s) expanding space”*** (See line 14), and “i.e. its fuel consumption” (See line 16) render the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Additionally, the recitations of ***“miracle physical reflections”***, ***“explosions...chambers that would be reduced due to...”***, and ***“meaning this system”*** render the claim indefinite, since it is not clear that how miracle the physical reflections are; explosions or chambers would be reduced; which system is to be meant.

9. For claims 42-54, applicant should base on the claims 33-41 as set forth above, to amend in compliance with 35 U.S.C. 112, second paragraph.

10. Regarding claim 33, line 11, the word "means" is preceded by the word(s) "to form hydraulic sliding rod pump" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the

equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. Undue experimentation requires imposed on one having ordinary skill in the art to make or use the invention.

Claims 33-54 are rejected under 35 U.S.C. 101 because the invention as disclosed is inoperative and therefore lacks utility. Applicant's invention belongs to a class of devices known as "closed pocket turbines" which are categorically inoperative. The definition of class 60, subclass 39.44 ("Closed Pocket Turbines") states that motive fluid introduced into these closed pockets is trapped therein, and while so trapped, is incapable of exerting any useful energy release by expansion, impulse or reaction. Engines of this type are considered to be inoperative to produce useful power.

The effective area of each pocket on which the pressure can act is the area of the leading and trailing pocket faces projected on a radial plane. This projected area is the same for both faces. The tendency to rotate is equal and opposite, and therefore there will be no rotation in the desired direction. The direction of the resultant force of the pressure in each pocket is radial, through the axis of the rotor, and therefore there is no tangential component of force. The existence of such a tangential force balance is completely independent of the shape of the rotor pocket.

In order to obtain useful power from the gases generated, said gases must be allowed to expand against a movable wall and exert forces of expansion by static pressure in a confined expansible space such as between a cylinder and a piston, or a high velocity jet of gas must be provided which is free to impact against vanes and immediately escape. In applicant's device there is no expansion of the gases because the volume of each pocket remains constant as the rotor rotates, also the high velocity jet of gas is not free to impact against vanes and immediately escape.

Since the intended mode of operation of applicant's device appears to conflict with well known and accepted principles, the presumption of inoperativeness is so strong that very clear evidence is required to overcome it. Therefore, applicant is required to submit a working model and/or affidavits from qualified, unbiased and disinterested persons who are familiar with the general principles involved in the operation of the device, attesting to its operativeness. A qualified person is one having an advanced degree in physics or mechanical engineering from a leading university such as Stanford, or the California Institute of Technology, or Massachusetts Institute of Technology, and an understanding of the combustion processes in internal combustion engines.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (703) 308-6450. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

Art Unit: 3748

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (703) 308-2623. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

However, the examiner's new telephone number (751) 272-4867 will become effective after the expected changeover date of November 22, 2004.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTB
October 5, 2004


Thai-Ba Trieu
Patent Examiner
Art Unit 3748